

REMARKS

Claims 1-25 are pending and stand subject to a restriction requirement based on PCT Rule 13.2 as to the following invention groups:

Group I, claims 1-9, drawn to method of making;

Group II, claims 10-17, drawn to image sheet;

Group III, claims 18-25, drawn to kit/package.

Applicant hereby elects Group I, claims 1-9, with traverse. The basis of the traversal is that, contrary to the assertion in the Action, independent claims 1, 10 and 18 (Groups I, II and III, respectfully) do each include the same or corresponding technical features which define a contribution over the art. The relevant technical feature is the layer of Shape Memory Polymer in combination with “an image key coat”. For a number of reasons, WO/01/87643 to Mabbott should not be viewed as defeating unity of invention.

In fact, the Written Opinion of the International Searching Authority for this PCT application specifically identified WO/01/87643 to Mabbott as the closest prior art. Not only did the Written Opinion fail to raise any unity of invention objections, but the Authorized Officer gave a reasoned statement that all claims 1-25 were novel and involved an inventive step over this reference. Likewise, the equivalent European application has since proceeded to acceptance and grant without any lack of unity objections.

In broad outline, the present invention relates to the provision of images on surfaces. In essence, the surface is “marked” with an image sheet which comprises a layer of a Shape Memory Polymer (SMP) having an image bonded thereto by means of “an image key coat.” The invention is briefly described in the paragraph bridging pages 3 and 4 of the present specification, and the relevant disclosure of WO/01/87643 is discussed on page 2.

The marking technique of the present invention may be applied to articles (e.g. shoes) which are to be supplied as “finished goods”. In this case, the “manufacturing factory” would carry out the method of claim 1. Alternatively, the image sheet (claim 10) may be supplied for home use by a person who wishes to “personalize” their possessions (see first paragraph on page 9). A further possibility is that a customer is supplied with a kit as defined in claims 19 and

applies their own image (e.g. using an ink jet printer) to the image key coat and then uses the resulting image sheet to provide a marking on an article (see final paragraph on page 11).

The advance that has been made, which is common to all of independent claims 1, 10, and 19, is the use of a flexible layer of a SMP provided with an image key coat. This latter coat serves for bonding an image to the layer of SMP. Independent claims 1 and 10 both include the additional limitation that there is an image bonded to the SMP by means of the image key coat. Independent claims 18 is directed to a “kit” incorporating the SMP layer with an image key coat layer to which an image may be applied.

The “special technical feature” identified above (i.e. the layer of the SMP in combination with the image key coat) is embodied in all of the independent claims, and for at least this reason, all of Groups I-III should be examined together in the present application. The more specific combination of the layer of SMP, image key coat, and an image bonded to the SMP by means of the image key coat is a feature of independent claims 1 and 10. Accordingly, at the very least, Groups I and II should be examined together in the present application.

In summary, Applicant elects Group I, claims 1-9 with traverse and respectively suggests that all claims (Groups I-III) or at least claims 1-17 (Groups I-II) should be examined together. The Examiner is invited to contact the undersigned to discuss any matters that would facilitate examination of this case.

Respectfully submitted,

By /John M. Bradshaw, 46,573/
John M. Bradshaw, 46,573
Woodard, Emhardt, Moriarty, McNett & Henry LLP
111 Monument Circle, Suite 3700
Indianapolis, Indiana 46204-5137
(317) 634-3456

October 20, 2008